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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Applicant: | Dasa Lipovsek et al. | Art Unit: | 1653 |
| Serial No.: | 09/688,566 | Examiner: | Audet, M.A. |
| Filed: | October 16, 2000 | Customer No.: | 31020 |
| Title: | PROTEIN SCAFFOLDS FOR ANTIBODY MIMICS AND OTHER BINDING PROTEINS | | |

Commissioner for Patents
Washington, D.C. 20231



REPLY TO RESTRICTION REQUIREMENT

In reply to the Restriction Requirement that was mailed in connection with the above-captioned case on October 2, 2002, Applicants elect the invention of Group I, claims 1-32, with traverse.

The claims in this case were divided into eight groups, four of which are reproduced below:

Group I Claims 1-32, drawn to non-antibody protein, classified in class 530, subclass 300+;

Group III Claim 34, drawn to a method of obtaining a derivative non-antibody protein utilizing a scaffold protein, classified in class 530, subclass

333 and/or 344;

Group IV Claim 35, drawn to a method of obtaining a derivative non-antibody protein utilizing a candidate protein, classified in class 530, subclass 333 and/or 344; and

Group V Claim 36, drawn to a method of obtaining a compound which binds to a non-antibody (candidate protein), classified in class 530, subclass 333 and/or 344.

Applicants traverse this restriction requirement because Groups I, III, IV, and V should properly be examined together for the following reasons.

First, the Office erred on pages 3-4 in characterizing Inventions I and III and also Inventions I and IV as product and process of use. Both cases are product and process of making the product (as indicated *by the Office* on page 2) and, therefore, the test for restriction used by the Office was incorrect. The proper test is described in MPEP 806.05(f). In light of the failure of the Office to provide valid reasons for restricting these groups under the 806.05(f) test, Groups I, III, and IV should properly be examined together.

Moreover, in restricting Groups I and V, the Office erred, on page 4, by providing an illogical example of a materially different process for using the product of Invention I. The Office states that the product, which is a recombinant protein, can be used in the recombinant production of protein. This, of course, is scientifically incorrect. In light of

the failure of the Office to provide an example that would be recognized by one skilled in the art to be logical and correct, Groups I and V should properly be examined together.

Further, the Office erred on page 4 in characterizing Inventions III, IV, V, and VI as processes of use for the product of Invention I. As explained above, Inventions III and IV are processes of making the product. Only Inventions V and VI are processes for use of the product.

Finally, the Office again erred on page 4 in failing to examine all the required questions to determine whether to restrict claims in Groups III and IV. The Office conceded (at page 4) that Inventions III and IV are related, and thus must show that they are distinct in order to justify restricting them to two groups. In order to show that they are distinct, the Office must show that they are patentable over each other. Since the Office did not even approach this question, the required showing has not been made and Inventions III and IV should properly be examined together.

For all of the above reasons, Applicants request that the claims of Groups I (claims 1-32), III (claim 34), IV (claim 35), and V (claim 36) be examined together in this application.

Enclosed is a petition to extend the period for replying for one month, to and including December 2, 2002. If there are any charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

Date: 26 November 2002

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